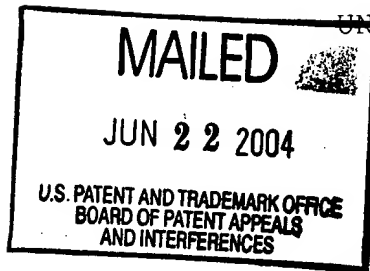


The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 22



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN L. SHANNON JR.

Appeal No. 2004-1291
Application No. 09/655,054

ON BRIEF

Before PAK, WALTZ, and KRATZ, Administrative Patent Judges.
WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's final rejection of claims 27 through 34, which are the only claims remaining in this application. We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellant, the invention is directed to a singles stick for adjusting the height of a tennis net to conform the net to regulation singles play, where the singles stick comprises a telescopic base and staff that can be pulled out into a single,

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extended and locked position or can be collapsed into a single, collapsed and locked position (Brief, pages 2-3). The staff carries spaced holes that cooperate with a locking pin for locking the base and staff together (Brief, page 3). A copy of representative independent claim 27 is attached as an Appendix to this decision.

The examiner has relied upon the following references as evidence of obviousness:

Cheney	4,976,432	Dec. 11, 1990
Zody	5,352,057	Oct. 04, 1994

The claims on appeal stand rejected under 35 U.S.C. § 103(a) as unpatentable over Cheney in view of Zody (Answer, page 4).¹ We reverse this ground of rejection for the reasons stated below.

OPINION

The examiner finds that "Cheney discloses a sectional and height adjustable singles stick, in which the sections are combined in order to achieve the desired and specifically claimed height for holding up a tennis net," where the "sections are connected by inserting the dowel end of a section into the hollow bottom end of another section (which is inherently a telescoping motion) to

¹The rejection of claims 27-32 under 35 U.S.C. § 102(b) over Miller, U.S. Patent No. 5,665,038, has been withdrawn by the examiner (Answer, page 3, ¶(5), and page 4, ¶(10)).

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achieve compact storage" (Answer, page 4). The examiner recognizes that Cheney does not disclose a locking pin for holding the sections in place but applies Zody as evidence that it was "commonly known within the sports equipment art" to use biased detent locking mechanisms for supporting adjustable, telescoping members in a desired position (Answer, page 5). From these findings, the examiner concludes that it would have been obvious to one having ordinary skill in the art to "utilize a biased or manually removable locking mechanism as taught by Zody in order to support the structure of Cheney in a desired position." Answer, page 6. We disagree.

As the examiner states, Cheney discloses a singles stick where sections are combined through insertion of a dowel from one section into the hollow bottom of another section "to achieve the desired and specifically claimed height for holding up a tennis net" (Answer, page 4; Cheney, col. 8, ll. 11-18). On this record, the examiner has not established any reason, suggestion or motivation for adding a locking mechanism, such as taught by Zody, to the dowel-connected sections of Cheney since these sections, as combined by Cheney, need no adjustment in height when the dowels are fully inserted into the adjacent section, other than the net height adjustment mechanism that accommodates various widths of

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tennis bands (col. 5, ll. 54-64). See *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). As correctly argued by appellant, the examiner has not shown any suggestion or teaching in the art for adjusting the height of Cheney's single stick by making it telescope in and out (Brief, page 7). We note that Cheney describes the connection of sections as a connection in "an end-to-end telescoping manner" (col. 10, claim 2). However, the examiner has failed to establish any reasoning, suggestion or motivation as to why one of ordinary skill in this art would have desired to add a locking mechanism to the dowel-connected sections of Cheney in order to adjust the height so that the dowels would not have been fully inserted. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification [citations omitted]"). Based on the above discussed disclosure and teachings of Cheney, any locking mechanism added to the dowel-connected sections of Cheney would be superfluous.

For the foregoing reasons, we determine that the examiner has not established a *prima facie* case of obviousness in view of the reference evidence. Therefore we cannot sustain the examiner's

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rejection of claims 27-34 under 35 U.S.C. § 103(a) over Cheney in view of Zody.

The decision of the examiner is reversed.

REVERSED


CHUNG K. PAK
Administrative Patent Judge

THOMAS A. WALTZ
Administrative Patent Judge

BOARD OF PATENT
APPEALS
AND
INTERFERENCES


PETER F. KRATZ
Administrative Patent Judge

TAW/lp

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APPENDIX

Claim 27. A singles stick for holding the top edge of a tennis net at its regulation height above the ground for singles play, which comprises:

- (a) a base having a bottom for engaging the ground;
- (b) a staff slidably connected to the base such that the base and staff can be pulled apart or pushed together between collapsed and extended positions thereof by sliding the base and staff relative to one another;
- (c) a fixed depth notch on top of the staff with the notch having an upwardly facing bottom, wherein a top support cord or cable of a tennis net can be placed within the notch and when so placed the top support cord or cable rests against and is retained against vertical movement by the bottom of the notch;
- (d) a lock which releasably secures the base and staff against sliding movement relative to one another when the lock is engaged, wherein the lock is configured to hold the base and staff in a single, predetermined, extended and locked position; and
- (e) wherein the combined length of the base and staff in the single, predetermined, extended and locked position of the base and staff is selected to hold the top edge of the tennis net above the ground by an amount required to conform the tennis net for regulation singles play when the singles stick is installed at a predetermined court location between a singles line and doubles line on one side of a tennis court, wherein a user can quickly and easily conform one side of the tennis net for regulation singles play without measurement by pulling the base and staff of the singles stick apart, by locking the base and staff of the singles stick together in the single, predetermined, extended and locked position that is provided therefor, and by then wedging the singles stick between the top support cord or cable and the ground at the predetermined court location, the singles stick when so wedged having the top cord or cable of the tennis net resting against the bottom of the notch on the staff with the bottom of the base resting against the ground.